



UNITED STATES PATENT AND TRADEMARK OFFICE

C/K

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,780	11/04/2003	Sue Feng	5725.0895-02	5902

22852 7590 06/15/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT PAPER NUMBER

1615

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,780

Applicant(s)

FENG ET AL

Examiner

JYOTHSNA A. VENKAT Ph. D

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 28, 40, 47, 72, 75, 80, 96-98, 101, 123, 135, 142, 167, 170, 175 and 191-206 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/22/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 1-3,6,28,40,47,72,75,80,96-98,101,123,135,142,167,170,175 and 191-206.

DETAILED ACTION

Receipt is acknowledged of Amendment to the claims, remarks and IDS filed on 3/22/05. Claims 4-5, 7-27, 29-39, 41-46, 48-71, 73-74, 76-79, 81-95, 99-100, 102-122, 124-134, 136-141, 143-166, 168-169, 171-174, 176-190 are canceled and claims 191-206 have been added as per applicant's amendment dated 3/22/05. Claims 1-3, 6, 28, 40, 47, 72, 75, 80, 96-98, 101, 123, 135, 142, 167, 170, 175 and 191-206 are pending in the application and the status of the application is as follows:

Information Disclosure Statement

The documents that have been crossed out have been considered. They will not be listed for printing.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 6, 40, 47, 96-98, 101, 135, and 142 rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent 6,423,324 ('324).

Claim construction

The specification at page 1, under paragraph 2 defines the dispersion of pigments (coloring agent) enhances properties like higher gloss. The claims are rejected based upon the prior art showing the lipstick having “ high gloss “ which is same as “ dispersing coloring agent”.

See examples 1-5, 6-7 and 15-16, which discloses “ polyamide resin”. This reads on the claimed hetero polymer. Castor oil and isoeicosane, reads on claimed the fatty phase. See col.14, line 46; col.15, lines 24 and 64; col.16, line41. The property intense color is inherent since all the lipsticks have intense color based upon the coring or pigment used.

3. Claims 1-3, 6, 28,40, 47, 96-98, 101,123,135, 142, 191-196, 198-206 rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent 6,402,408.

Claim construction

The specification at page 1, under paragraph 2 defines the dispersion of pigments (coloring agent) enhances properties like higher gloss. The claims are rejected based upon the prior art showing the lipstick having “ high gloss “ which is same as “ dispersing coloring agent”.

See examples 1-2 wherein Uniclear 80 is the species claimed, pigments read on the claimed coloring agent, pearl oil are the claimed fatty phase. Uniclear 100, disclosed at col.4, lines 46 is another claimed species.

Claim Rejections - 35 USC § 103

4. Claims 1-3, 6, 28, 40, 47, 72, 75, 80, 96-98, 101, 123, 135, 142,167,170,175 and 191-206 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of patents 5,783,657 and ' 324 and '408 and '917.

Claim construction

The specification at page 1, under paragraph 2 defines the dispersion of pigments (coloring agent) enhances properties like higher gloss. The claims are rejected based upon the prior art '324 and '408 showing the lipstick having " high gloss " which is same as " dispersing coloring agent".

5.

The instant application is claiming a method for dispersing at least one coloring agent in a compositions comprising:

- 1. Coloring agent*
- 2. Heteropolymer (the subgenus is formula I and the species are claimed in 191-194, 200-201 and 204-205)*
- 3. Fatty phase (claims 47,142,196)*
- 4. Polysaccharide resin (claims 72,167 and 197)*
- 5. Film-forming polymer (75, 170 and 198)*
- 6. Fatty alcohol (claims 80, 175 and 199)*

Patent '657 teaches ester-terminated polyamide resins of formula I claimed in the instant application useful in cosmetics. See the abstract, see col.2, lines 25 ET seq and see col.3, 30-39 for the utility of the resin in the various cosmetic products. See also col.s 4-9 for the resin of formula I and the preparation of the resin, see also col.14, lines 29-33 where the patent clearly teaches the combination of the patent and adding **colorants** to the resin so that it can be used in lipstick. The patent at the same col. 14, lines 34-44 teaches the application of the resin. The patent at col.15, lines 15 et seq and col.16, lines 1-25 teaches fatty phase. The patent at col.15,

Art Unit: 1615

lines 42-43 teaches that the resin are self-supporting and the patent at the paragraph bridging col.s 16-17 teaches that the resins do not display "synergism". The patent does not disclose the species claimed or ingredients 4-6. Patent '324 teaches broadly polyamide resins along with fatty alcohols at col.5, lines 51 et seq. the difference between the polyamide resin of '657 and '324 is in one of the starting material to make the resin. Formula I uses diacid as polymerized fatty acid whereas patent '324 uses polycarboxylic acid. Patent '324 clearly teaches method of dispersing color to the lipstick. Patent '408 teaches dispersing coloring agent to the composition using formula I and also species. The patent teaches fatty phase, and also utility of the various resins at col.7, lines 42-55. All the above patents are cited to show that the resin claimed broadly or as formula I or species claimed in cosmetic compositions. The patent does not teach ingredients 4-5 in the cosmetic compositions. However patent '917 teaches ingredients 4-5 in the cosmetic compositions. See film-former at col.2, lines 10 et seq. See col.3, lines 1-5. See col.3, lines 23-45 for the coloring agents and see the same col.3, lines 49-55 for the polysaccharide resin.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of patent '657 or 324 or '608 using the resin and combine it with film former and polysaccharide resin expecting beneficial effect to the consumer. The idea of combining ingredients flows logically from the art. One of ordinary skill in the art would certainly be motivated to combine the ingredients with the reasonable expectation of success that by substituting polyamide resin of '324 with the resin of '657 has the additional advantage of giving structure and also it exhibits synergism like the polyamide resin "Versamid" and the polyamide resin of '657 can be used in various cosmetic products and also exhibit dispersing coloring agent since all the products claimed have coloring agent and adding

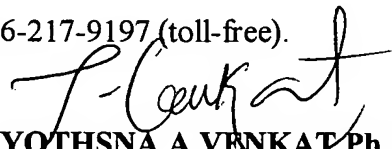
Art Unit: 1615

film former has the advantage of forming film over the cosmetic product and adding saccharide resin is needed in the compositions since it is dispersion enhancing agent and it provides the advantage of having viscosity at a useful level. This is prima facie case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K. PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JYOTHSNA A VENKAT Ph. D
Primary Examiner
Art Unit 1615
